



AF
JFW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| | | | |
|---|----------------------|------------------------|--------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 09/276,598 | |
| | Filing Date | 3/25/99 | |
| | First Named Inventor | Denison W. Bollay | |
| | Art Unit | 3691 | |
| | Examiner Name | Charles, Debra F. | |
| Total Number of Pages in This Submission | 122 | Attorney Docket Number | D-1507 |

| ENCLOSURES (Check all that apply) | | |
|---|--|---|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to TC |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input checked="" type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input checked="" type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Terminal Disclaimer | (1) Appeal brief (3 copies) 40 ppges |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> Request for Refund | (2) Return Receipt Postcard |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | <input type="checkbox"/> CD, Number of CD(s) _____ | |
| <input type="checkbox"/> Reply to Missing Parts/Incomplete Application | <input type="checkbox"/> Landscape Table on CD | |
| <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | Remarks This is in response to Notification of Non-compliant Appeal Brief. | |
| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | | |
| Firm Name | | |
| Signature | <i>Owen L. Lamb</i> | |
| Printed name | Owen L. Lamb | |
| Date | December 28, 2006 | Reg. No. 20831 |

| CERTIFICATE OF TRANSMISSION/MAILING | | | |
|---|---------------------|------|-------------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: | | | |
| Signature | <i>Owen L. Lamb</i> | | |
| Typed or printed name | Owen L. Lamb | Date | December 28, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

D-1507

Re app. of: Denison W. Bollay

Serial Number: 09/276,598

Filed: 3/25/99

Title: A Method of Executing an Electronic Commerce

Sale from an Affiliate Web Site with a Vendor

Through a Hub Server in One Step Without

Reentering Shipping and Payment Information

Examiner: Charles, D.F.

GROUP ART UNIT: 3691

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Commissioner of Patents & Trademarks

PO Box 1450

Alexandria, VA 22313-1450

Sir:

This is a response to a Notice of Non-Compliant Appeal Brief mailed 12/05/2006. Three copies of a revised appeal brief are submitted herewith as required by the rules. Acceptance of the revised Appeal Brief is respectfully requested.

Date: December 28, 2006

PO Box 386

Prescott AZ 86302-0386

Respectfully submitted,

Owen L. Lamb, Reg. #20,831

Attorney for applicant

Phone: (928) 776-8037

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Priority Mail on the date shown below in an envelope addressed to:

Commissioner for Patents

PO Box 1450

Arlington, Virginia 22313-1450

December 28, 2006

Owen L. Lamb, Reg. # 20,831

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re app. of: Denison W. Bollay
Serial Number: 09/276,598
Filed: 3/25/99

Examiner: Charles, D. F.
GROUP ART UNIT: 3691

Title: A Method Of Executing An Electronic Commerce
Sale From An Affiliate Web Site With A Vendor
Through A Hub Server In One Step Without
Reentering Shipping and Payment Information

APPEAL BRIEF

| | |
|--------------------------------------|---|
| 1. REAL PARTY IN INTEREST | 2 |
| 2. RELATED APPEALS AND INTERFERENCES | 2 |
| 3. STATUS OF CLAIMS | 2 |
| 4. STATUS OF AMENDMENTS | 2 |
| 5. SUMMARY OF THE INVENTION | 2 |
| 6. ISSUES | 4 |
| 7. GROUPING OF CLAIMS | 4 |
| 8. ARGUMENT | 5 |

Summary of Prior Art

Detailed Description of the Prior Art

Summary of Argument for Patentability

Argument for Patentability

ISSUE 1. Are claims 18 and 22 anticipated by Alloul under 35 U.S.C. 102(e)? 12

ISSUE 2. Are claims 1-20 and 25-29 unpatentable under 35 U.S.C. 103(a)

over Alloul in view of Deaton? 14

ISSUE 3. Are claims 19, 20, 21, 23 and 24 unpatentable under

35 U.S.C. 103(a) over Alloul in view of Official Notice? 20

9. APPENDIX A (COPY OF DECISION ON PETITION) 31

10. APPENDIX B (COPY OF APPEALED CLAIMS) 32

1. REAL PARTY IN INTEREST

Upon information and belief, this invention has not been assigned and the inventor, Denison W. Bollay is the owner thereof.

2. RELATED APPEALS AND INTERFERENCES

A Petition to Withdraw Holding of Abandonment was filed on April 8, 2005. The petition was granted on August 23, 2006. A copy of the Decision on Petition is in Appendix A. There are no other related appeals or interferences.

3. STATUS OF CLAIMS

Claims 13-17 have been cancelled.

Claims 1-12, 18-19 and 20-30 are pending and are the subject of this appeal.

Through numbering error, claim 20 does not exist in the claims as originally filed.

The original numbering is retained in this brief.

Claims 18 and 22 stand rejected under 35 USC 102(e) over US Patent US 6,032,130 to Alloul.

Claims 1-12, 25 and 26-29 stand rejected under 35 USC 103(a) over Alloul in view of Deaton, et al US 5,687,322.

Claims 19, 20, 21, 23 and 24 stand rejected under 35 USC 103(a) over Alloul in view of Official Notice.

4. STATUS OF AMENDMENTS

An "Amendment After Notice Of Appeal" has not been entered.

5. SUMMARY OF THE INVENTION

Applicant claims a method of processing multiple electronic transactions at a hub server 100. Three databases are stored at the hub, a vendor product information database, a buyer profile database, and an affiliate web site database. The product information is referenced by a number of affiliate web sites 108, 110, 112, that display products of many vendors for a commission. Buyer credit card or payment method and shipping information of one or more buyers, including a particular buyer 114, are stored in the buyer profile database during the first purchase from an affiliate web site 110. When a purchase request (cookie, affiliate # and product) of the particular buyer 114 is received at the hub server 100 from one of the affiliate web sites 110, the previously-stored buyer credit and shipping information of the particular buyer is combined with product selection received from the affiliate site resulting in combined purchase order information. The combined purchase order information is recorded and the purchase request is forwarded from the hub server 100 to the vendor's web site 106. The hub server 100 bills the buyer's credit card, credits the affiliate site with its commission and credits the vendor (vender # 3) with the sale. The vendor site ships the product.

The hub server dynamically creates HTML code and/or JavaScript needed to submit a purchase request if the user clicks on an icon/button. This HTML and JavaScript is dynamically inserted into the page with an <IFRAME>, JavaScript, or similar tag.

The invention has the advantage that it enables a sale to be completed without the buyer leaving the affiliate's site to go to the vendor's web site because the transaction details are processed by the hub server.

The invention has the advantage that a buyer need enter credit card and ship to data only once and can visit any Site in the affiliate network later without having to reenter the data, even though new products from new vendors may be subsequently featured on any site.

6. ISSUES.

This is an appeal from the final rejection of Claims 1-12 and 18-29.

Applicant does not desire an oral hearing.

ISSUE 1. Are claims 18 and 22 anticipated by Alloul under 35 U.S.C. 102(e)?

ISSUE 2. Are claims 1-12, 25 and 26-29 unpatentable under 35 U.S.C. 103(a) over Alloul in view of Deaton?

ISSUE 3. Are claims 19, 20, 21, 23 and 24 unpatentable under 35 U.S.C. 103(a) over Alloul in view of Official Notice?

7. GROUPING OF CLAIMS.

There are 5 groups of claims:

- (1) Claims 1-6 and 27
- (2) Claims 7-12, 28 and 29
- (3) Claims 18, 23, and 25
- (4) Claims 19-21, 24 and 26
- (5) Claim 22

Claims 1, 7, 18, 19 and 22 are independent claims.

The claims of each group do not stand or fall together. The reasons why the claims of each group are separately patentable are set forth in the argument under section 8 below.

8. ARGUMENT

Summary of Prior Art

On the Internet, electronic transactions are processed at a vendor's server. A single vendor web site displays products of this one vendor. Buyer credit card or payment method and shipping information of one or more buyers, including a particular buyer, is stored at the vendor's server during the first purchase from the vendor's web site. When a purchase request of the particular buyer is received at the vendor server from the vendor's web site, the stored buyer credit and shipping information of the particular buyer is combined with product selection received from the vendor site resulting in combined purchase order information. The combined purchase order information is recorded at the vendor's server. The vendor's server bills the buyer's credit card. The vendor site ships the product.

There is no provision in the prior art for handling sales for multiple vendors that advertise products on affiliate web sites. If a buyer wishes to purchase a product advertised on a web site other than the original vendor's site, the buyer is transferred by a link to the new vendor's site. All information must be re-entered into that new vendor's server as described above with respect to the original vendor.

In Alloul product information supplied by several vendors is stored locally as a catalog on a disc drive at a kiosk in a shopping mall or on a CD Rom at a personal computer (PC) in a user's home. In applicant's invention product information supplied by several vendors is stored at a hub server and transferred to a number of affiliate web sites. Alloul does not employ affiliate web sites.

In Alloul, variable product information, such as price and availability data supplied by the several vendors, are stored remotely in a transaction server. The catalog data stored locally and the data received from the remote server are combined at the kiosk or PC in order to provide both real-time and up-to-date product information to the kiosk or PC. The Alloul purchasing system stores large product multimedia catalogs on local mass storage means and allows at the same time small volumes of time-variable data to be obtained by telecommunication means from a remote server. The principle is to have a high bandwidth part of the presented data coming from the fixed storage means that allow quick data

access for large graphical files, and a low bandwidth communication means for time-variable data coming from a remote server via a network.

In applicant's invention all product information, including price and availability, is stored at a hub server and transferred to a number of affiliate web sites. There is no need to store a catalog locally at a kiosk or PC. A customer obtains the catalog information by accessing the affiliate web sites over the Internet. Alloul does not employ affiliate web sites.

Detailed Description of the Prior Art

Alloul, et al Patent 6,032,130 (Alloul)

Alloul discloses an electronic purchasing system, which provides a real-time multimedia product presentation for customers using a combination of locally stored data and transmitted data. A multimedia product catalog is stored on a local server for fast data access. Two versions of the local server are disclosed: an electronic purchasing kiosk intended to be installed in malls and shopping centers for public access and a personal computer (PC) based purchasing system intended for personal use at home or at the office. Price and/or availability data from suppliers, are received at the local server (kiosk or PC) over a network from a transaction server. The connection is bi-directional allowing electronic payment for purchased products, price corrections, stock availability checking and product ordering to be done almost instantly.

First, the customer starts a browser-type application program leading him through product catalogs stored locally on a kiosk in a shopping center or on a CD on a PC. That application may comprise a multimedia browser module for product browsing and multimedia presentation wherein data is coming both from the product database stored locally on the purchasing system and from the remote transaction server. While browsing, the customer may fill a shopping cart. The client will then be asked to confirm the current purchase and insert a credit card for billing into a credit card reader.

As described in the following excerpt from the Alloul patent, the transaction server runs one or more application programs, which allow performing the following functions for the client' terminals (kiosks or PCs):

- “1. Accept an incoming call from a remote kiosk;
2. Accept a data package giving SKU (or similar), quantity, shipping address and billing information and transmit time-variable information to the client's terminals such as the price and availability;
3. Verify the order against the database and transmit shipping information back to the client's terminal;
4. Perform a credit card verification or forward the data to banks for performing a remote credit card verification;
5. Permit the system to obtain financial and accounting information.”

The primary focus of Alloul is a kiosk multimedia application using a caching mechanism designed to overcome Internet bandwidth limitations that broadband Internet access have now overcome: "It is an object of the present invention to provide in real-time up-to-date and easy-to-use multimedia product catalogs for customers.... " "stores large product multimedia catalogs on local mass storage means and allows at the same time small volumes of time-variable data to be obtained by telecommunication means."

Alloul further provides a multimedia catalog purchasing system comprising: mass storage means for storing locally at least one electronic multimedia catalog containing a large volume of product-related data representing each of a plurality of products to be sold. While browsing catalogs, the client may "fill a shopping cart", i.e. prepare an editable list of items to be purchased. The client may then confirm the transaction and finally may make an electronic payment for paying for the purchase: the client may insert a credit card or a debit card to be charged into the electronic payment card reader.

Deaton et al 5,687,322 (Deaton)

Deaton discloses check transaction processing system in which customer's identification code, along with customer transaction data, is entered at the point-of-sale. A memory stores a database of previously entered customer identification codes and transactions data. Circuitry is provided for generating a

signal representative of a customer's shopping history, wherein incentive coupons may be issued to customers in dependence upon the signal.

The check transaction processing system enables a store with a significant volume of check transactions to accumulate and process transactional customer information for check verification and customer profiles for target marketing. The system operates at a store using a local database of customer information useful in that store's business. The customer database of customer information includes credit verification status and transaction frequency and dollar volume over specified intervals. The customer information can be used for credit verification, targeted customer marketing and other customer relation's purposes.

Deaton teaches a credit verification system using a customer id like a checking account number to reduce credit risk in a bricks-and-mortar store. Its teachings have little to with online transactions, and "operates at an individual store, and maintains at that store a local customer database of customer records, each identified by the corresponding customer identification number."

Summary of Argument for Patentability

Applicant provides a method and system for single-action ordering of items in a client/hub server/affiliates/vendors environment, wherein the hub server stands between the client and multiple vendors and products that are displayed on an affiliate's web page. The single-action ordering system reduces the number of

purchaser interactions needed to place orders from multiple affiliates and eliminates sensitive information that would be transmitted between a client system and the server systems of multiple vendors if existing systems were employed. The hub server system assigns a unique client identifier to each client system. The hub server system also stores purchaser-specific order information for various potential purchasers. The purchaser-specific order information is collected from a previous order placed by a purchaser. The hub server system maps each client identifier to a purchaser that may use that client system to place an order. A purchaser employs a client system (a browser) to view an affiliate's web page wherein different vendor's products are displayed, whereas in the past only the orders for the one vendor can be processed, and only at the vendor's web site.

In applicant's invention, when a purchaser wants to place an order, the purchaser employs the client system to send the request for information describing the item to be ordered along with its client identifier to the hub server. The hub server sends the requested information (e.g., via a Web page) to the client computer system along with an indication of the single action to perform to place the order for the item. With single-action ordering, the purchaser need only perform a single action (e.g., click a mouse button) to order the item. When the purchaser performs that single action, this causes the client system to notify the hub server system. The hub server system then completes the order by adding the purchaser-specific order information (i.e. ship to address, etc.) for the purchaser

that is mapped to that client identifier to the item order information (e.g., product identifier and quantity). The hub server forwards item order information to the vendor who ships the product. Since the vendor server and hub server are different, multiple vendors are accommodated. In applicant's invention only the hub server stores credit card numbers, minimizing potential misuse of sensitive financial information.

Once the description of an item is displayed on the client, the purchaser need only take a single action to place the order to purchase that item regardless of which one of many vendors provides the item. Also, since the client identifier identifies purchaser-specific order information already stored at the hub server system, there is no need for such sensitive information to be transmitted via the Internet or other communications medium to the vendor. The vendor ships the product and the hub server bills the purchaser's credit card, credits the appropriate vendor with the sale and credits the affiliate with a commission. Neither Alloul nor Deaton has nor do they suggest a mechanism to handle multiple affiliates and multiple vendors.

Thus it is apparent that the prior art does not provide a mechanism or method wherein multiple vendors can display their wares on affiliate web site(s) and receive orders for items and a ship to address (via the hub server) without dealing with sensitive credit card information. One instance only of sensitive credit card information is maintained at one hub server, not multiple vendor

servers. In the prior art, multiple servers, maintained by multiple vendors maintain multiple instances of sensitive credit card information. Applicant's invention eliminates this by providing a central source of credit card information, bills the buyer for a purchase, credits the affiliate with a commission for the sale and credits the vendor for the sale.

Neither Alloul, nor Deaton disclose or suggest applicant's invention, either taken alone or in combination.

Argument for Patentability

ISSUE 1

Are claims 18 and 22 anticipated by Alloul under 35 U.S.C. 102(e)?

Point 1. None of the references show nor suggest applicant's claimed invention

Claims 18 and 22 are independent claims.

Alloul does not provide a mechanism or method wherein multiple vendors can display their wares on affiliate web site(s) and receive orders for items and a ship to address (via the hub server) without dealing with sensitive credit card information. In applicant's invention, one instance only of sensitive credit card information is maintained at one hub server, not multiple vendor servers. In Alloul, multiple vendor servers, maintained by multiple vendors receive multiple

instances of sensitive credit card information. Through the use of affiliate web sites upon which vendors display their wares, applicant's invention eliminates multiple entry of credit card information by providing a central source of credit card information, bills the buyer for a purchase, credits the affiliate with a commission for the sale and credits the vendor for the sale.

The distinguishing language in the claims is as follows:

Claim 18:

Transferring said product information to a number of affiliate web sites;

Receiving buyer billing and shipping information of one or more buyers, including a particular buyer, from affiliate web sites;

Receiving a purchase request of said particular buyer from one of said affiliate web sites;

Forwarding said combined purchase order information to said vendor.

Claim 22:

causing identifiers of a buyer, an affiliate web site, a product, and a vendor site, to be sent to said hub server in response to a buyer that browses an affiliate web site clicking on a displayed vendor product;

sending, from said hub server to said particular user, a form including said picture of said product, its price and a submit icon superimposed on said picture; returning said form, from said buyer to said hub server, upon a condition that said buyer clicks on said submit icon;

debiting, at said hub server, said buyer's credit card with said purchase price;

ISSUE 2.

Are claims 1-12 and 25-29 unpatentable under 35 U.S.C. 103(a) over Alloul in view of Deaton?

Point 2. None of the references suggest combining them in the manner that the Examiner has.

Claims 1 and 7 are independent claims.

For the reasons set forth more fully below, it is respectfully submitted that Alloul and Deaton are inappropriate references for combining.

Examiner states that it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the teaching of Alloul with Deaton's "buyer profile database".

Examiner states that Alloul fails to teach a buyer profile database but that Deaton teaches a buyer profile database. Examiner then states that it would have been obvious to one of ordinary skill in the art to use this limitation for the advantage of more likely meeting market demand by target marketing based on consumer profiling.

The result that applicant is after is not “the advantage of more likely meeting market demand by target marketing based on consumer profiling”. Applicant’s invention is a method wherein multiple vendors can display their wares on one or more affiliate web sites and receive orders for items and a ship to address (via the hub server) without having to deal with sensitive credit card information.

While target marketing may be an admirable by product, it is the elimination of multiple instances of sensitive credit card information that is at the essence of applicant’s invention. Security and lack of confidence in on-line transactions on the Internet are well-known and long-standing problems.

None of the references disclose nor suggest applicant’s claimed invention because none disclose or suggest necessary elements of the claimed combination. None of the references disclose or suggest combining stored buyer information with product selection from an affiliate and forwarding the combined purchase order information from said hub server to a vendor. The distinguishing language in the claims is as follows:

Claim 1:

Combining stored buyer information of said particular buyer with product selection from one of said affiliate sites upon a condition that a purchase request of said particular buyer is received, resulting in combined purchase order information being sent to the hub server; and,

Forwarding said combined purchase order information from said hub server to a vendor.

Claim 7:

Combining stored buyer billing and shipping information of said particular buyer with product selection received from one of said affiliate sites upon a condition that a purchase request of said particular buyer is received, resulting in combined purchase order information;

Recording said combined purchase order information at said hub server; and,

Forwarding said combined purchase order information from said hub server to a vendor.

The dependent claims are subject to the same limitations and arguments.

The Examiner has applied the references to separate elements of the combination rather than to the combination viewed as a whole. 35 USC 103 requires that "the subject matter as a whole" be considered in determining what would have been obvious.

None of the references suggest combining the references in the manner that the Examiner has. The Examiner cites Alloul as a primary reference to teach all of the limitations except: Alloul does not teach "a buyer profile database", for which Examiner cites Deaton.

The Examiner concludes:

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this limitation for the advantage of being more efficient by centralizing the profiling and purchasing function to more likely meet market demand by target marketing based on consumer profiling

All that Deaton teaches on this point is that a Database of customer information may be maintained to aid in assessing credit risk for credit verification and other information for marketing or other purposes. The Examiner does not point out where in the references it is suggested that such a combination is possible or even desirable.

In re Larson

The Examiner cites In re Larson, 340 F.2d 965, 144 USPQ 347, 349 (CCPA 1965) for the proposition that making integral, i.e. the combined purchase order, is an obvious choice to create a single unit. In Larson a claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means. The brake disc and clamp of the prior art comprises several parts rigidly secured together as a single unit.

In applicant's claim 1 applicant stored buyer information is combined with product selection from an affiliate site upon a condition that a purchase request of said particular buyer is received. This results in combined purchase order information being sent to a hub server; the combined purchase order information being forwarded from the hub server to a vendor. By introducing affiliate cites not disclosed in the prior art, applicant solves a long-standing security problem on the Internet, showing insight that is contrary to the understandings and expectations of the prior art.

Point 3. The Examiner has failed to set forth a *prima facie* case of obviousness for rejections combining references under 35 USC 103 (obviousness).

The MPEP at 706.02 (j) sets forth a process by which a rejection under 35 USC 103 is to be sustained wherein, as in the present case, a single reference (Alloul) is modified by combining it with one or more references (Deaton):

The Examiner has failed to set forth a *prima facie* case of obviousness. The MPEP states that to establish a *prima facie* case of obviousness three basic criteria must be met:

- (1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.
- (2) There must be some reasonable expectation of success.
- (3) The references when combined must teach or suggest all the claim limitations.

These three criteria are analyzed below in order to show why the references cannot be properly combined:

- (1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.

The claims were rejected as being unpatentable over Alloul in view of Deaton. Deaton is the primary reference relied upon, and is the "reference" referred to in Step 1. Alloul is the reference to be modified.

The Examiner proposes that it would be obvious to modify the applied reference (Alloul) to use the elements of Deaton to provide the claimed electronic commerce method. The Examiner has failed to point out why the modification that he proposes would be obvious.

Applicant's invention is a combination and the crucial suggestion or motivation step in determining obviousness must be considered. The Examiner has failed to do this. Neither Alloul nor Deaton contains anything to suggest the desirability of applicant's claimed combination or any motivation to modify the method of Alloul to effectuate a multiple e-commerce transaction. In order to satisfy this requirement, the Examiner must show that at least one of the references suggests that it is possible or desirable to modify the applied reference to effectuate a multiple e-commerce transaction.

(2) There must be some reasonable expectation of success.

There is no reasonable expectation of success in combining the references in the manner that the Examiner suggests because there is no provision for multiple affiliates and multiple vendors. Therefore, the result of the proposed combining would not succeed in providing method by which a buyer can execute a sale from an affiliate web site with a vendor through a hub server without leaving the web site, or reentering the user's payment and shipping information.

(3) the references when combined must teach or suggest all the claim limitations.

The references do not teach combining stored buyer information with product selection from an affiliate site upon a condition that a purchase request of a particular buyer is received, resulting in combined purchase order information being sent to the hub server, which forwards it to a vendor.

Point 4 The Alloul patent and the Deaton Publication teach away from the combination taught by applicant's invention.

A careful reading of the references, shows that not only is there no suggestion of making the Examiner's proposed modification to Alloul, as per Deaton, but to the contrary the references specifically teach in the opposite direction from making such modification.

Neither Alloul nor Deaton has nor do they suggest a mechanism to handle multiple affiliates and multiple vendors.

In Alloul and Deaton, the teaching is that multiple servers, maintained by multiple vendors must maintain multiple instances of sensitive credit card information. Alloul and Deaton do not teach a mechanism or method wherein multiple vendors can display their wares on affiliate web site(s) and receive orders for

items and a ship to address (via a hub server) without dealing with sensitive credit card information. Applicant's invention provides a central source of credit card information, bills the buyer for a purchase, credits the affiliate with a commission for the sale and credits the vendor for the sale. One instance only of sensitive credit card information is maintained at one hub server, not multiple vendor servers.

In re Dulberg

The Examiner cites In re Dulberg, 289 F.2d 522, 129 USPQ 348, 349 (CCPA 1961) for the proposition that making separable, as in the introduction of affiliates, is not sufficient in itself to distinguish over an old invention. In Dulberg, the claimed structure was a lipstick holder with a removable cap. The claimed structure was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose".

Claims 18 and 22 claim a combination that includes a vendor web site, a hub server, and affiliate web sites. The Examiner has not shown that the claimed structure is fully met by the prior art and has not articulated from what prior art combination the affiliate sites are separated. Since affiliate sites are not present

in the Alloul et al patent in any form they cannot be separated out as Examiner suggests.

ISSUE 3.

Are claims 19, 20, 21, 23 and 24 unpatentable under 35 U.S.C. 103(a) over Alloul in view of Official Notice?

Point 5. None of the references suggest combining them in the manner that the Examiner has.

Claim 19 and 22 are independent claims and claims 20, 21 and 24 are dependent thereon.

None of the patents disclose or suggest applicant's claimed invention because none disclose or suggest necessary elements of the claimed combination. None of the references disclose or suggest combining stored buyer information with product selection from an affiliate and forwarding the combined purchase order information from a hub server to a vendor. The distinguishing language in the claims is as follows:

Claims 19-21:

C. Receiving at said hub server, a cookie, said cookie identifying a prospective buyer, said affiliate site, said product and optionally said vendor site;

D. Dynamically creating a <FORM> including all information necessary to effect a purchase transaction;

F. Forwarding a purchase request for said product to be shipped to said buyer to a vendor upon a condition that said <FORM> is submitted to said hub server.

None of the references disclose or suggest dynamically creating a <FORM> including all information necessary to effect a purchase transaction and forwarding a purchase request for said product to be shipped to said buyer to a vendor upon a condition that said <FORM> is submitted to said hub server by a user. None of the references disclose or suggest using a cookie identifying a prospective buyer, said affiliate site, said product and optionally said vendor site.

The dependent claims are subject to the same limitations and arguments.

Point 6 The Examiner has failed to set forth a *prima facie* case of obviousness for rejections combining references under 35 USC 103 (obviousness).

The MPEP at 706.02 (j) sets forth a process by which a rejection under 35 USC 103 is to be sustained wherein, as in the present case, a single reference (Alloul) is modified by combining it with one or more references (Official Notice):

The Examiner has failed to set forth a *prima facie* case of obviousness. The MPEP states that to establish a *prima facie* case of obviousness three basic criteria must be met:

(1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.

(2) There must be some reasonable expectation of success.

(3) The references when combined must teach or suggest all the claim limitations.

These three criteria are analyzed below in order to show why the references cannot be properly combined:

(1) There must be some suggestion or motivation to modify the reference or to combine reference teachings.

As to motivation the Examiner is silent, stating only that:

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement this feature for the

advantage of identifying a buyer and thus establishing a profile
candidate for marketing purposes

The result that applicant is after is not "the advantage of identifying a buyer and thus establishing a profile candidate for marketing purposes". Applicant's invention is a method wherein multiple vendors can display their wares on one or more affiliate web sites and receive orders for items and a ship to address (via the hub server) without having to deal with sensitive credit card information.

While target marketing may be an admirable by product, it is the elimination of multiple instances of sensitive credit card information that is at the essence of applicant's invention. Security on the Internet is a well-known and long-standing problem.

None of the references disclose nor suggest applicant's claimed invention because none disclose or suggest necessary elements of the claimed combination. None of the references disclose or suggest combining stored buyer information with product selection from an affiliate and forwarding the combined purchase order information from said hub server to a vendor. The distinguishing language in the claims is as follows:

Claim 19:

D. Dynamically creating a <FORM> including all information
necessary to effect a purchase transaction;

E. Returning a picture of said product with a submit image and said <FORM> to said particular user; and,

F. Forwarding a purchase request for said product to be shipped to said buyer to a vendor upon a condition that said <FORM> is submitted to said hub server.

The claims were rejected as being unpatentable over Alloul and Official Notice. Alloul appears to be the primary reference relied upon, and is the "reference" referred to in Step 1. Alloul is the reference to be modified.

The Examiner proposes that it would be obvious to modify the applied reference (Alloul) to use the elements of Official Notice to provide the Cookie identifier. The Examiner has failed to point out why the modification that he proposes would be obvious. The claims call for "said cookie identifying a prospective buyer, said affiliate site, said product and optionally said vendor site". There is no suggestion that a cookie be used to identify an affiliate site in addition to identifying a prospective buyer.

Applicant's invention is a combination and the crucial suggestion or motivation step in determining obviousness must be considered. The Examiner has failed to do this. Neither Alloul nor Official Notice contain anything to suggest the desirability of applicant's claimed combination or any motivation to modify the method of Alloul to effectuate a cookie be used to identify an affiliate site in addition to identifying a prospective buyer. In order to satisfy this requirement,

the Examiner must show that at least one of the references suggests that it is possible or desirable to modify the applied reference to effectuate a cookie be used to identify an affiliate site in addition to identifying a prospective buyer.

(2) There must be some reasonable expectation of success.

There is no reasonable expectation of success in combining the references in the manner that the Examiner suggests because there is no provision for multiple affiliates and multiple vendors. Therefore, the result of the proposed combining would not succeed in providing method by which a buyer can execute a sale from an affiliate web site with a vendor through a hub server without leaving the web site, or reentering the user's payment and shipping information.

(3) the references when combined must teach or suggest all the claim limitations.

The references do not teach combining stored buyer information with product selection from an affiliate site upon a condition that a purchase request of a particular buyer is received, resulting in combined purchase order information being sent to the hub server, which forwards it to a vendor.

Official Notice only teaches the use of a cookie to identify a buyer at a vendor's site. There is therefore no reasonable expectation of success in combining the references in the manner that the Examiner suggests.

(3) The references when combined must teach or suggest all the claim limitations. There is no express or implied teaching in any of the references that stored buyer information can be combined with product selection from an affiliate site upon a condition that a purchase request of a particular buyer is received, resulting in combined purchase order information being sent to the hub server which forwards it to a vendor.

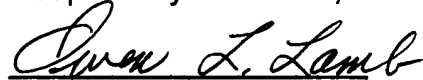
The Board of Appeals is respectfully requested to reverse the Examiner's decision and to instruct the Examiner to allow claims 1-12 and 18-29.

Date: December 28, 2006

P.O. Box 386

Prescott, AZ 86302

Respectfully submitted,



Owen L. Lamb,

Attorney Reg.#20,831

(928) 776-8037

9. APPENDIX A (COPY OF DECISION ON PETITION)



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OWEN L. LAMB
P.O. BOX 386
PRESCOTT, AZ 86302-0386

COPY MAILED

AUG 23 2006

OFFICE OF PETITIONS

| | | |
|-----------------------------|---|----------------------|
| In re Application of Bollay | : | |
| Application No. 09/276,598 | : | Decision on Petition |
| Filing Date: March 25, 1999 | : | |
| Attorney Docket No. D-1507 | : | |

This is a decision on the petition under 37 CFR 1.181, filed August 23, 2004, and supplemented April 8, 2005, to withdraw the holding of abandonment.

The petition is granted.

Facts:

A proper request to change the address of record was filed February 7, 2003. The Office failed to change the address of record.

Papers mailed July 1, 2003, notified petitioner of deficiencies within the brief and provided petitioner with the longer of 30 days or 1 month to file a corrected brief. The papers were mailed to the old, incorrect address. Petitioner failed to receive the papers mailed July 1, 2003.

A Notice of Abandonment was mailed March 22, 2004. The Notice of Abandonment was mailed to the old, incorrect address.


Discussion:

Petitioner has demonstrated non-receipt of the papers mailed July 1, 2003.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Technology Center Art Unit 3624 will be informed of the instant decision and the examiner will consider the corrected brief and other papers filed April 8, 2005, in due course.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.


Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

10. APPENDIX B (COPY OF APPEALED CLAIMS)

1. A method of processing multiple electronic transactions at a hub server comprising:

Maintaining a vendor product information database of product information at said hub server;

Said product information being accessible by a number of affiliate web sites;

Maintaining an affiliate web site database at said hub server;

Maintaining a buyer profile database of buyer information of one or more buyers, including a particular buyer, at said hub server;

Combining stored buyer information of said particular buyer with product selection from one of said affiliate sites upon a condition that a purchase request of said particular buyer is received, resulting in combined purchase order information being sent to the hub server; and,

Forwarding said combined purchase order information from said hub server to a vendor.

2. The method of claim 1 wherein said particular buyer information is stored in said buyer profile database during a first purchase by said particular buyer at an affiliate web site.

3. The method of claim 1 wherein said step of forwarding said combined purchase order information from said hub server to said particular buyer comprises:

Dynamically creating computer code needed to submit a purchase request upon a condition that said particular buyer selects a submit icon displayed on a web page; and,

Inserting said computer code into said web page with a tag.

4. The method of claim 2 wherein said step of forwarding said combined purchase order information from said hub server to said particular buyer comprises:

Dynamically creating computer code needed to submit a purchase request upon a condition that said particular buyer selects a submit icon displayed on a web page; and,

Inserting said computer code into said web page with a tag.

5. The method of claim 3 wherein said computer code is one or more of HTML code and JavaScript; and, wherein said tag is one or more of an <IFRAME> and JavaScript.

6. The method of claim 4 wherein said computer code is one or more of HTML code and JavaScript; and wherein said tag is one or more of an <IFRAME> and JavaScript.

7. A method of processing multiple electronic transactions at a hub server comprising:

Maintaining a vendor product information database of product information at said hub server;

Said product information being accessible by a number of affiliate web sites;

Maintaining an affiliate web site database at said hub server;

Maintaining a buyer profile database of buyer billing and shipping information of one or more buyers, including a particular buyer, at said hub server;

Combining stored buyer billing and shipping information of said particular buyer with product selection received from one of said affiliate sites upon a condition that a purchase request of said particular buyer is received, resulting in combined purchase order information;

Recording said combined purchase order information at said hub server; and,

Forwarding said combined purchase order information from said hub server to a vendor.

8. The method of claim 7 wherein said particular buyer billing and shipping information is stored in said buyer profile database during a first purchase involving said particular buyer at an affiliate web site.

9. The method of claim 7 wherein said step of forwarding said combined purchase order information from said hub server to said particular buyer comprises:

Dynamically creating computer code needed to submit a purchase request upon a condition that said particular buyer selects a submit icon displayed on a web page; and,

Inserting said computer code into said web page with a tag.

130. The method of claim 8 wherein said step of forwarding said combined purchase order information from said hub server to said particular buyer comprises:

Dynamically creating computer code needed to submit a purchase request upon a condition that said particular buyer selects a submit icon displayed on a web page; and,

Inserting said computer code into said web page with a tag.

11. The method of claim 9 wherein said computer code is one or more of HTML code and JavaScript; and wherein said tag is one or more of an <IFRAME> and JavaScript.

12. The method of claim 10 wherein said tag is one or more of an <IFRAME> and JavaScript; and wherein said tag is one or more of an <IFRAME> and JavaScript.

18. A method of processing multiple electronic transactions at a hub server comprising:

Accessing vendor product information from a vendor web site;

Storing said product information at said hub server;

Transferring said product information to a number of affiliate web sites;

Receiving buyer billing and shipping information of one or more buyers, including a particular buyer, from affiliate web sites;

Storing said buyer billing and shipping information at said hub server;

Receiving a purchase request of said particular buyer from one of said affiliate web sites;

Combining said stored buyer billing and shipping information of said particular buyer with product selection information received from said affiliate site resulting in combined purchase order information; and,

Forwarding said combined purchase order information to said vendor.

19. A method of enabling multiple and different remote Internet resident affiliate web sites to allow users to effect purchases at a separate vendor web site comprising:

- A. Storing, in a database at a hub server, specific buyer information, including billing and shipping information;
- B. Generating a number of templates, each template corresponding to a product (or product category) to be displayed on an affiliate web page;
- C. Receiving at said hub server, a cookie, said cookie identifying a prospective buyer, said affiliate site, said product and optionally said vendor site;
- D. Dynamically creating a <FORM> including all information necessary to effect a purchase transaction;
- E. Returning a picture of said product with a submit image and said <FORM> to said particular user; and,
- F. Forwarding a purchase request for said product to be shipped to said buyer to a vendor upon a condition that said <FORM> is submitted to said hub server.

20. No such claim in original filing.

21. The method of claim 20 further comprising:

- G. Arranging said picture of said product and a submit image on screen such that a purchase request can be initiated by selecting said submit image.

22. The method of claim 20 wherein said <form> includes product code, price, affiliate ID and vendor ID.

23. In system of electronic commerce in which a central hub server stands between a number of affiliate web sites and a number of vendor web sites to execute sales of vendor products featured on said affiliate web sites, a method comprising:

associating a number of affiliate web sites with said hub server;

selecting, at said affiliate web sites, products offered by vendors;

displaying selected products to users on said affiliate web pages;

causing identifiers of a buyer, an affiliate web site, a product, and a vendor site, to be sent to said hub server in response to a buyer that browses an affiliate web site clicking on a displayed vendor product ;

searching a database at said hub server to find a picture of said product, its current price and previously stored credit information and shipping address of said buyer;

sending, from said hub server to said particular user, a form including said picture of said product, its price and a submit icon superimposed on said picture; returning said form, from said buyer to said hub server, upon a condition that said buyer clicks on said submit icon;

debiting, at said hub server, said buyer's credit card with said purchase price;

crediting said vendor site with a sale less a commission credited to said affiliate site;

submitting to said vendor all information necessary to make a purchase: product code, price, affiliate site, vendor ID, buyer ID and shipping address; and,

processing said sale at said vendor site, including shipping said product to said shipping address in said form.

24. The method of claim 18 wherein said step of transferring said product information to a particular user includes selecting said product information randomly within a category.

25. The method of claim 19 wherein said step of generating a number of templates, each template corresponding to a product to be displayed at an affiliate web site includes selecting a product randomly within a category.

26. The method of claim 18 wherein said step of transferring said product information to a particular user includes selecting said product based on one or more of a buyer's profile, affiliate site and category.

27. The method of claim 19 wherein said step of generating a number of templates, each template corresponding to a product to be displayed at an affiliate web site includes selecting said product based on one or more of a buyer's profile, affiliate site and category.

28. The method of claim 1 wherein said step of forwarding said combined purchase order information from said hub server to a vendor includes selecting said vendor based on price or aggregation efficiency.

29. The method of claim 7 wherein said step of forwarding said combined purchase order information from said hub server to a vendor includes selecting said vendor based on price or aggregation efficiency.

30. The method of claim 8 wherein said step of forwarding said combined purchase order information from said hub server to a vendor includes selecting said vendor based on price or aggregation efficiency.